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10/000,219

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EXAMINER

DUONG, THANH P

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAFUMI NISHITANI
and MASAEI TSURUMAKI

Appeal 2008-4625
Application 10/000,219
Technology Center 1700

Decided: December 18, 2008

Before CHARLES F. WARREN, CATHERINE Q. TIMM, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 1, 3 through 7, 9 through 12, and 15 through 48 in the Office Action mailed December 20, 2006. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2007).

The appeal was heard November 18, 2008.

We reverse the decision of the Primary Examiner.

Claim 1 illustrates Appellants' invention of a golf club, and is representative of the claims on appeal:

1. A golf club of wood-type having a hollow head body, comprising a shaft; and

a metal head attached to the shaft, wherein the metal head comprises a body having an opening in which a striking face member is disposed, the striking face member including a plurality of metal pieces; and

wherein said plurality of metal pieces are fixed together by laser welding and press forming is performed on the plurality of metal pieces that are fixed together to form a curved surface portion of the striking face member.

The Examiner relies upon the evidence in these references (Ans. 2-3):

Shaw	US 5,423,535	Jun. 13, 1995
Galy	US 5,971,867	Oct. 26, 1999
Kosugi	US 6,106,412	Aug. 22, 2000
Peterson	US 6,339,869 B1	Jan. 22, 2002
Chen	US 6,368,233 B1	Apr. 9, 2002
Ciasullo	US 6,739,094 B1	May 25, 2004

Appellants request review of the following grounds of rejection advanced on appeal by the Examiner (App. Br. 4 and 12-13):

claims 1, 3 through 7, 10 through 12, 17 through 26, 33 through 40, and 43 through 45 under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Chen (Ans. 3);

claims 24 through 26, 40, and 46 under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Ciasullo (Ans. 5);

claims 1, 3 through 7, 9 through 12, 15 through 23, 43, and 44 under 35 U.S.C. § 103(a) as unpatentable over (Ans. 6);

claims 27 through 29, 41, and 47 under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Peterson (Ans. 8); and,

claims 30 through 32, 42, and 48 under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Galy (Ans. 10).

The issue in this appeal is whether, on this record, Appellants have shown that the golf club as claimed is not anticipated by or obvious over the prior art as applied by the Examiner.

The plain language of representative independent claim 1 specifies a golf club comprising at least, among other things, a metal head with a striking face member prepared by a process of fixing together a plurality of metal pieces by laser welding and press forming the so fixed together metal pieces to form a curved portion of the striking face. Accordingly, contrary to the Examiner's position (Ans., e.g., 4-5 and 11-12) as argued by Appellants (*see, e.g.,* App. Br. 21-22), the process steps of laser welding and subsequent press forming define the structure of the claimed striking face element, and it is the patentability of a golf club containing this structure which is determined over the prior art without consideration of the process used to form the prior art golf club(s). *See, e.g., In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985) ("even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself") (citing, *inter alia, In re Brown*, 459 F.2d 531, 535 (CCPA 1972); *In re Pilkington*, 411 F.2d 1345, 1348 (CCPA 1969)). Our claim interpretation determinations apply in similar manner to the claim language of independent claims 7, 21, 24, 27, and 30, and the dependent claims.

We find the written description in the Specification details the difference in structure between golf clubs prepared by laser welding and conventional arc welding. Spec. 1-2. We find that the structure imparted by

conventional welding to golf clubs was recognized in the prior art as evinced by Peterson. Peterson, e.g., col. 1, l. 46 to col. 2, l. 6. We find the testimonial evidence in the Hiruta Declaration¹ shows differences between structures prepared using laser welding and conventional welding. Hiruta Declaration 2-6.

As Appellants point out, the Examiner did not consider the structure of the golf club as claimed in the appealed claims as we interpreted these claims above. *See* Ans. in entirety. Indeed, the Examiner did not consider the testimonial evidence in the Hiruta Declaration. *See* Ans. 11-16.

The Examiner's refusal to give effect to the structure imparted to the claimed golf clubs by the product-by-process limitations is improper. *See In re Angstadt*, 537 F.2d 498, 501 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 1262-63 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 450 (CCPA 1970). Thus, as Appellants contend, the Examiner has not established a prima facie case of anticipation or of obviousness over the applied references because the claimed golf club encompassed by the claims has not been compared with the prior art golf clubs. *See, e.g., In re Spada*, 911 F.2d 705, 707 n.3 (Fed. Cir. 1990) *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Accordingly, we determine that Appellants have shown that the golf club as claimed is not anticipation as a matter of fact and/or obviousness as a matter of law over the prior art as applied by the Examiner, and in the absence of a prima facie case of in each of the grounds of rejection advanced on appeal, we reverse each of the grounds of rejection.

¹ Declaration Under 37 C.F.R. § 1.132 of Masamoi Hiruta executed September 7, 2006 and submitted with the Amendment filed September 26,

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The Primary Examiner's decision is reversed.

REVERSED

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